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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,850	01/26/2004	Joerg Mueller	CM2587CQ	9786

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EXAMINER

BOGART, MICHAEL G

ART UNIT PAPER NUMBER

3761

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TJH

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,850	<b>Applicant(s)</b> MUELLER ET AL.	
	<b>Examiner</b> Michael G. Bogart	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08 Apr. 2004</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it exceed 150 words in length.

Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections – 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Present claims 1-5 relate to a product defined by reference to desirable characteristics or properties defined by the use of parameters, namely the saturation capacity, the retention capacity and the intake time for a first insult. The claims cover all products having this characteristic or property, whereas the application provides enablement within the meaning of 35 USC § 112 first paragraph for only a very limited number of such products. In the present case, the claims so lack support, and the application so lacks disclosure, that a meaningful search over the whole of the claimed scope is impossible. For example, the specification refers to acceptable

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elastic materials at page 10, acceptable topsheets, back sheets and absorbent cores at pages 20-21, but no specific combinations which achieve the claimed test results relating to stretchability.

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-5, claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.—*Ex parte Slob* (PO BdApp) 157 USPQ 172.

Claims 6-12 are indefinite because they depend from indefinite claim 1.

### ***Claim Rejections – 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Endres *et al.* (EP 0 433 951 A2).

Regarding claim 13, Endre *et al.* teach a wearable absorbent article (10), preferably diaper or pull-on pants, having a backsheet (30) and a topsheet (26) comprising a first waist region (46) , a second waist region (44), and a crotch region (24) interposed there between, a longitudinal axis, and an opening (38), which provides a passageway to a primary void space (56) for receiving bodily exudates therein, positioned between the topsheet (26) and the backsheet (30); whereby the opening (38) is positioned in at least the crotch region (24) along the longitudinal axis; whereby the topsheet (26) is elasticated (68).

The reference is silent as to the steps for producing the article.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). MPEP § 2113.

There are not claimed steps which necessarily lead to a finished article which is materially different from that of the cited reference.

***Claim Rejections – 35 USC § 102/103***

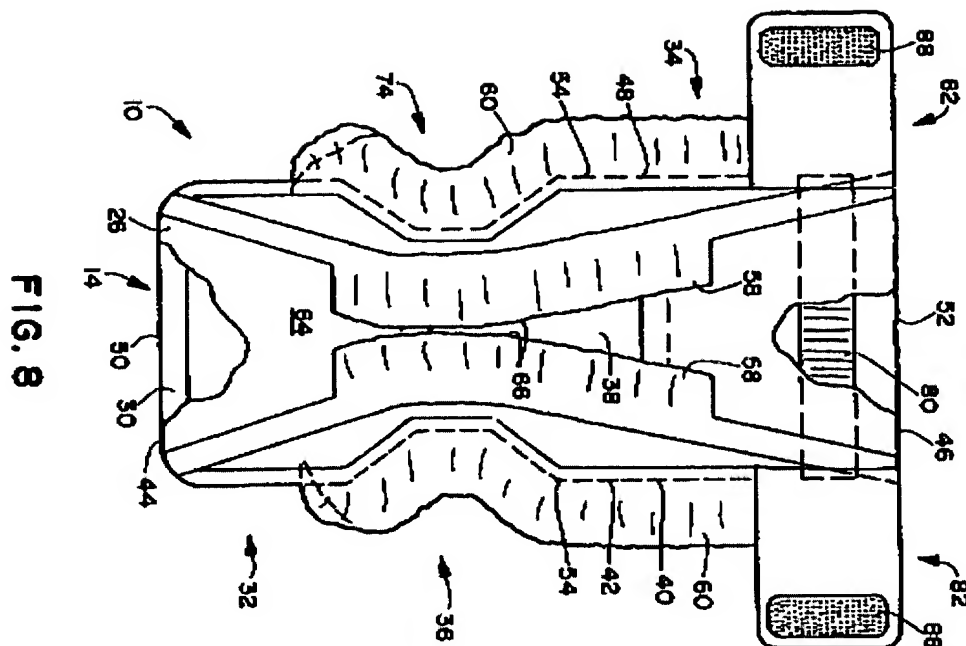
The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-12 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Endres *et al.*

Regarding claims 1-3, Endres *et al.* teach an absorbent article (10) having a backsheet (30) and a topsheet (26) comprising a first waist region (46), a second waist region (44), and a crotch region (24) interposed there between, a longitudinal axis, and an opening (38), which provides a passageway to a primary void space (56) for receiving bodily exudates therein, positioned between the topsheet (26) and the backsheet (30); whereby the opening (38) is positioned in at least the crotch region (24) along the longitudinal axis; whereby the topsheet (26) is elasticated (68)(see fig. 8, below).



Endres *et al.* are silent as to the stretch characteristics of the absorbent article.

Given the elastic elements of the reference, it should inherently meet the stretch performance of the claimed invention.

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. §§ 102 or 103. “The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. § 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). MPEP § 2112.

In the alternative rejection under 35 USC § 103, generally, differences in ranges of values will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such range of values. “[W]here the general conditions of a claim are

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disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Regarding claims 1-5, the benefits of optimizing the dimensions of elastic regions in relaxed and stretched states and the relative elasticity of the elastic regions to each other would have been known prior to applying a test, making these values result-effective variables. One of ordinary skill in the art would have recognized that changing dimensions to fit a variety of wearer sizes, or that optimizing the relative elasticity of the elastic regions to provide the desired amount of elasticity.

Regarding claim 6, Endres *et al.* teach a slit opening (38) comprising longitudinally opposing side edges (66), each having one or more elasticated regions (58, 68) disposed along each of the side edges (66), preferably the length of the slit opening (38) being less than the length of the topsheet (26) and the elastic regions (58) being longer than the side edges (66), extending longitudinally from said side edges (66).

Regarding claim 7, Endres *et al.* teach a first waistband (46), adjacent to the first waist region (46) of the topsheet (26), to which one end of each of the elasticated regions (68) are connected, and a second waistband, adjacent to the second waist region (44) of the topsheet (26), to which the other end portion of each elasticated regions (68) are connected.

Regarding claim 8, Endres *et al.* do not tech the specific dimensions of the elastic band.



In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Regarding claim 9, Endres *et al.* teach an elasticated regions (58, 68) in relaxed position are positioned under an angle with the adjacent area of the topsheet (26), such that the elasticated regions (58, 68) bend away from the void space (56)(see figure 5, below).

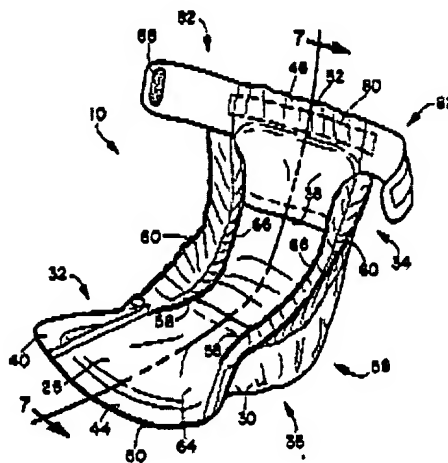


FIG. 5

Regarding claim 10, Endres *et al.* teach elasticated regions (58, 68) that have each a first and second end edge and a first and second center point located therein between, the elastic regions (58, 68) each being curved such that the shortest distance between the first end edge of one elastic region and the first end edge of the other elastic region and also the shortest distance between the second end edge of one elastic region and the second end edge of the other elastic

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region, are both larger than the shortest distance between the shortest distance between the first and second center point of the elasticated regions (see figure 8, *supra*).

Regarding claim 11, Endres *et al.* teach a diaper (see figure 8).

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Endre *et al.* as applied to claims 1-11 above, and further in view of Roe (US 5,607,760 A).

Endres *et al.* do not teach a body lotion.

Roe teaches a diaper having a topsheet with a body lotion for skin comfort.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the lotion of Roe to the diaper of Endres *et al.* in order to provide a more comfortable topsheet.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart  
30 November 2005

**TATYANA ZALUKAEVA**  
**SUPERVISORY PRIMARY EXAMINER**

